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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,428	10/26/2000	Bruce A Beadle	AUS9200000120US1	4820

7590 09/08/2004

DILLON & YUDELL LLP  
8911 NORTH CAPITAL OF TEXAS HIGHWAY  
AUSTIN, TX 78759

EXAMINER
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THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/697,428	<b>Applicant(s)</b> BEADLE, BRUCE A	
	<b>Examiner</b> Marc D. Thompson	<b>Art Unit</b> 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10-13 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-13 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
3. Applicant's submission filed on 5/14/2004 has been entered.
4. Claims 2-5, 10-13, and 18-21 remain pending.

#### ***Priority***

5. No claim for priority has been made in this application.
6. The effective filing date for the subject matter defined in the pending claims in this application is 10/26/2000.

#### ***Drawings***

7. The Examiner contends that the drawings submitted on 10/25/2000 are acceptable for examination proceedings.

***Specification***

8. The Examiner notes multiple copies of the specification present in the image file wrapper of this application. Examiner also notes various one page amendments to the specification, along with marked up copies of the specification present in the IFW. The different amendments to the specification makes it unclear what the current specification contains, and in order to ensure compliance with substitute specification submissions, two (2) copies of the specification must be submitted, including a clean copy of the substitute specification as amended, and a marked up copy reflecting the changes from previously, entered amendments to the specification. In order to unambiguously clarify the exact contents of the current specification, it is required that Applicant respond with a clean copy of the current specification, and a marked up copy of the specification ***relative to the originally filed specification***. That is, one (1) marked up copy of the original specification which reflects the current state of the specification, and one (1) clean copy of the current specification, after all amendments, is required.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, lacks patentable utility, and is inoperative, therefore lacking utility.

11. Claim 21 recites a “computer program product”, reciting a software program, per se, and constitutes non-statutory subject matter. See, inter alia, MPEP § 2106. The claimed programming methodology fails to fall within one of the five categories of statutory subject

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matter, namely, new and useful process, machine, manufacture, composition of matter, or any new and useful improvement thereof, since the methodology is not recited as effecting a functional change in conjunction with any recited computing hardware. Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. See MPEP § 2106(IV)(B)(1)(B). No imparted functionality between the medium and the computer has been recited or identified, nor any interrelationship between the claimed programmatic data and functional activity of the computer has been specifically recited.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 21 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 21 recites a “product product” in the first line of the claim. It is presumed this is an overlooked typographical error.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

16. Claims 2-5, 10-13, and 18-21 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Marais et al. (“Supporting cooperative and personal surfing with a desktop assistant”, Proceedings of the 10<sup>th</sup> annual ACM symposium on User interface software and technology, 1997), hereinafter referred to as Marais.

17. Marais disclosed creation of “bookmark” web page entr(ies) both automatic keyword generation based on actual HTML content and various heuristic processing, optionally in response to user input of topical interest. See, inter alia, Section 3.1. Also see Figure 4, for usage of HTML 3.2 which inherently incorporated “metadata” fields for parsing/extraction and subsequent document classification/categorization. Marais also disclosed local client searching of pages (inter alia, Section 3.2), “auto-bookmarking” Section 4.1) client user keyword definition(s) (inter alia, Section 4.2), and automated clustering (inter alia, Section 6).

18. Thus, it is clear that Marias clearly disclosed the invention as broadly claimed.

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19. Claims 2-5, 10-13, and 18-21 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Douglass et al. (U.S. Patent Application Publication Number US 2002/0040311), hereinafter referred to as Douglass.

20. Douglass disclosed the automatic extraction of keywords/metadata from visited/bookmarked webpages, and user modification of these descriptive keyword(s). See, inter alia, Figure 1, and Page 2, Paragraphs [0020] through [0028]. Clearly, keyword fields were defined to designate particular keywords for the page(s) in the "Keyword Library" and storage of relevancy ratings. See, inter alia, step (26) and (40). The automatic generation of keywords for document(s) was disclosed as performed, inter alia, in step (30).

21. Claims 2-5, 10-13, and 18-21 are rejected.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later



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invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

24. Claims 2-5, 10-13, and 18-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bates et al. (U.S. Patent Number 6,100,890), hereinafter referred to as Bates, in view of what would have been obvious to one of ordinary skill in the art at the time of invention.

25. Bates disclosed the categorization of bookmarks (i.e., “hotlists”) in a typical browser environment. See, inter alia, Figure 10B. The use of keywords to describe the pages and categories was readily evident. See, inter alia, Figure 10A. The invention set forth by Bates simply automatically categorizes bookmark entries relating to visited network documents, gathers information relating to keyword associations, and categorizes the entries accordingly. See, inter alia, Column 14, Lines 13-38.

26. While Bates disclosed the invention substantially as claimed, Bates did not specifically disclose two distinct features of the claimed invention. The first of these features involves the ability for the Bates system to operate on “user-selected” bookmarks rather than automatically categorizing every single visited page. See, Column 12, Line 48 through Column 13, Line 63, and Column 15, Lines 10-12. It is presumed that the inclusion of the functional inventive behavior, solely in response to user selected bookmarks, exclusively or not, was within the scope of one with ordinary skill in the art at the time of invention. There was no mandate that the invention be fully executed each time a page was viewed, or each time a bookmark was stored, although, this was also within an ordinary artisan’s scope of knowledge. See, inter alia, Column 5, Lines 14-30, and Column 10, Lines 5-26. The method as set forth would have been

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easily recognized as equally suited to user-selected sites as well as every single site. Likewise, the omission of non-desired functions is also an obvious variation of the invention. See, inter alia, MPEP § 2144.04.

27. The remaining feature Bates did not expressly disclose included the generation of “metadata” or keyword determination in the absence of associated keyword data for a particular page. See, inter alia, Column 10, Lines 27-45, and Column 13, Line 57 through Column 14, Line 38. It should be noted that HTML was specifically recited in the disclosure (Column 4, Lines 43-60, and Column 8, Lines 32-46), allowing incorporation of valid HTML version(s) available at the time of filing, including version 3.2, inherently incorporating metadata fields as part of the HTML document itself. Thus, inclusion of the metadata describing the document was implicitly disclosed. Also, Bates did disclose the matching of category data from the title and content of the document itself. See, inter alia, Column 13, Lines 9-39. Thus, in failure of specifically stored/retrieved metadata, keyword data was gathered from the document itself, thereby being generated/determined. It is clear that this data was subsequently used to categorize particular bookmarks.

28. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Bates to perform methodology exclusively when the user selects such operation(s) to occur, and to generate keyword data from the document itself when this information was not readily present. The former provided a better utilization of resources (not wasting resources to perform functions not required or desired), and the latter allowing dynamic categorization of page(s), in addition to pre-determined categorization determinations.

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29. Thus, the combination of Bates and knowledge within scope of one with ordinary skill in the art at the time of invention disclosed the invention in claims 2-5, 10-13, and 18-21.

***Response to Arguments***

30. The arguments presented by Applicant in the response, received on 5/14/2004, are not considered persuasive. Applicant argues:

1. Applicant argues the prior art of record does not disclose “allowing the user to edit the keyword field of the entry in the hotlist of pages”. See, inter alia, Page 11 of the Response. It is submitted the newly cited and applied prior art contained this broadly characterized feature at the time of filing.

2. Applicant argues the prior art of record does not disclose “automatically generating a group of keywords based on the content of the page”. See, inter alia, Pages 11-12 of the Response. It is submitted the newly cited and applied prior art also contained this broadly characterized feature.

3. Lastly, Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

4. The breadth of the claimed invention is such that a multitude of art is directly applicable. Applicant is asked to review carefully all of the art cited here and prior to this action, in order to properly distinguish the claimed invention from the prior art of record. Extensive discussion of the claimed invention and any actual/potential differences must be clearly defined. Examiner reserves the right to apply any of the prior art of record as appropriate.

***Conclusion***

31. It is presumed that claims 10-13 invoke “means plus function” language and interpretation in accordance with 35 USC 112, sixth paragraph. In order to verify and ascertain the metes and bounds of the claimed invention, Applicant is requested to isolate the portion(s) of the specification which dictates the structure relied on for proper interpretation if this presumption is appropriate.

32. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 703-308-6750. The examiner can normally be reached on Monday-Friday, 9am-4pm. Note: The Examiner expects to move to the new PTO site in Carlyle in the next few months, and contact information will change at that time. If not available at the above number, The Examiner, if present at the new location, may be reached at 571-272-3932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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Marc D. Thompson  
Primary Examiner  
Art Unit 2144

MARC D. THOMPSON  
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PRIMARY EXAMINER